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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,500	09/28/2004	David Stockbower	200200006	4027

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EXAMINER

SAVAGE, MATTHEW O

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,500

Applicant(s)

STOCKBOWER, DAVID

Examiner

Matthew O. Savage

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 10-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, and 9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/28/04, 10/18/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 8, and 9, drawn to a filter cartridge.

Group II, claim(s) 4-7, and 10-13, drawn to a filtration module.

Group III, claim(s) 14 and 15, drawn to an end cap for a filter cartridge.

Group IV, claim(s) 16 and 17, drawing to a housing for a filtration module.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the special technical feature of the first end cap having at least two flanges formed integrally therewith shared by groups I-III does not provide a contribution over the prior art as evidenced by the rejection under 35 U.S.C. 102 listed below, and because group IV lacks the special technical feature listed above.

During a telephone conversation with Mr. Timothy King on 10-27-05 a provisional election was made without traverse to prosecute the invention of group I, claims 1-3, 8, and 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-7, and 10-17 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the groove recited in

Art Unit: 1724

claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not

Art Unit: 1724

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately disclose the groove structure recited in claim 9 in conjunction with a filter species including an end cap having flanges.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 8, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning line 7 of claim 1, it is unclear as to how the "passageway" can be "sealed to said first end cap" since no structure for defining the "passageway" has been recited in the claim. In addition, "said first end cap plate" lacks proper antecedent basis.

Regarding line 2 of claim 8, it is unclear as to what point of reference is used to define "outer".

Concerning line 2 of claim 9, it is unclear as to what point of reference is used to define "lower". On line 3, "said bowl" lacks antecedent basis.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Stankowski.

With respect to claim 1, Stankowski discloses an elongated filter medium 2a having a first end and a second end (see FIG. 1), a first end cap (e.g., the upper end cap) sealed to the first end, the first end cap having two flanges 35 (see FIG. 10a) formed integrally therewith, the flanges extending outward from an outer vertical surface of the filter medium, a second end cap (the lower end cap shown in FIG. 1) sealed to the second end, and a fluid passageway (e.g., sealed to outlet 3, see FIG. 1) sealed to the first end cap plate to provide fluid communication with the open interior within the filter medium, and a fluid porous housing 29 (see FIG. 11).

Concerning claim 2, Stankowski discloses a depth filter (see paragraph 105).

As to claim 3, Stankowski discloses a pleated filter (see paragraphs 90 and 105).

Regarding claim 8, Stankowski discloses each of the flanges 35 as having a boss 36 on an outside surface of each of the flanges.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stankowski in view of Pall et al.

Stankowski discloses flanges (see FIG.15) but fails to specify a groove on the lower surface of each of the flanges. Pall et al discloses the concept of providing a groove on a lower surface of a flanges 16, 17 of a filter element end cap 1 (see FIGS. 1-2) and suggests that such an arrangement provides a lug structure for attaching the filter to a housing (see lines 21-22 of col. 3). It would have been obvious to have modified the filter of Stankowski so as to have included a groove on the lower surface as suggested by Pall et al in order to provide a lug structure for attaching the filter to a particular housing.

Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koelfgen in view of Briggs.

With respect to claim 1, Koelfgen discloses an elongated filter medium 86 having a first end and a second end, a first end cap 82 sealed to the first end, the first end cap having two flanges 110 formed integrally therewith, the flanges extending outward from an outer vertical surface of the filter medium, a second end cap 84 sealed to the second end, and a fluid passageway 92 sealed to the first end cap plate to provide fluid communication with the open interior within the filter medium. Koelfgen fails to specify the fluid porous housing. Briggs discloses the concept of providing a fluid porous housing 10 for a filter element and suggests that the housing provides additional support and protection for the filter media. It would have been obvious to have modified

the filter of Koelfgen so as to have included the fluid porous housing as suggested by Briggs in order to provide additional support and protection for the filter media.

Concerning claim 3, Briggs discloses a pleated filter 16.

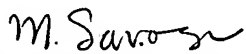
Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koelfgen in view of Briggs as applied to claim 1 above, and further in view of Swanson.

With respect to claim 2, Koelfgen and Briggs fail to specify a depth filter medium. Swanson et al discloses a depth filter medium and suggests that such a medium is capable of providing secondary filtration of oil of a diesel engine. It would have been obvious to have modified the combination suggested by Koelfgen and Briggs so as to have included a depth filter medium as suggested by Swanson et al in order to provide secondary filtration for a diesel engine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew O Savage
Primary Examiner
Art Unit 1724

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October 27, 2005